

REMARKS

Claims 1-19 have been examined and have been rejected under 35 U.S.C. § 103(a).

I. Rejections under 35 U.S.C. § 103(a) in view of DE 4316349 to Lieber ("Lieber") and U.S. Patent No. 5,074,245 to Ota et al. ("Ota")

The Examiner has rejected claims 1-13, 15-17 and 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieber in view of Ota.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited references. For example, claim 1 recites, "the device for processing further comprising a first ring-shaped plate and a second ring-shaped plate provided inside the enclosure and formed so as to surround the tube, wherein the first ring-shaped plate is axially offset from the second ring-shaped plate so that the first ring-shaped plate is provided above the window of the wall of the enclosure and the second ring-shaped plate is provided below the window of the wall of the enclosure."

Applicant submits that neither Lieber nor Ota teach or suggest the claimed ring-shaped plates. As set forth on page 6 of the present Application, the ring-shaped plates, i.e., elements 28 and 30, form short circuits for the electromagnetic field introduced into the enclosure so as to axially confine the field to have a maximum intensity level of the effective treatment area.

At least based on the foregoing, Applicant submits that claim 1 is patentable over the cited references.

B. Claims 2-7 and 9

Applicant submits that claims 2-7 and 9 are patentable at least by virtue of their dependency. In addition, claims 2-7 and 9 recite various dimensions of the claimed enclosure. The Examiner contends that it would have been a matter of obvious design choice for one of ordinary skill in the art to select/optimize the inside diameter of the enclosure (pg. 4 of Office Action).

In regard to the above, Applicant notes that as discussed in the MPEP¹, it is only a design choice to optimize variables that have been established as result effective. For example, *In Re Boesch and Slaney*² is only applicable to the optimization of a variable that has been recognized as achieving a result. In *In Re Boesch and Slaney*, the claims were directed to a material having specific amounts of nickel and other elements. The Board of Patent Appeals and Interferences found that “lowering the Nv value of a Co-Cr-Ni alloy and deletion of metals not consumed in precipitation from the Nv calculation are expressly suggested” (emphasis added) by prior art reference U.S. Patent No. 3,837,838.³ The U.S. Court of Customs and Patent Appeals relied on this evidence regarding modifying the specific amounts of material when it upheld the Board’s decision.

¹ See MPEP §2144.05.II.B. (page 2100-143).

² *In Re Boesch and Slaney*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

³ *In Re Boesch*, 617 F.2d at 276, 205 USPQ at 219.

In contrast, in the present case, there is no such evidence of any suggestion regarding modifying the inside diameter of the alleged enclosures of Lieber or Ota so that it is within one of the recited ranges:

C. Claims 8, 10-13, 15-17 and 19

Applicant submits that claims 8, 10-13, 15-17 and 19 are patentable at least by virtue of their dependency.

II. Rejection under 35 U.S.C. § 103(a) in view of Lieber, Ota and U.S. Patent No. 5,225,740 to Ohkawa ("Ohkawa").

The Examiner has rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieber, Ota and Ohkawa. Since claim 14 is dependent upon claim 1, and Ohkawa fails to cure the deficient teachings of Lieber and Ota, in regard to claim 1, Applicant submits that claim 14 is patentable at least by virtue of its dependency.

III. Rejection under 35 U.S.C. § 103(a) in view of Lieber, Ota and U.S. Patent No. 4,970,435 to Tanaka et al. ("Tanaka").

The Examiner has rejected claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieber, Ota and Tanaka. Since claim 18 is dependent upon claim 1, and Tanaka fails to cure the deficient teachings of Lieber and Ota, in regard to claim 1, Applicant submits that claim 18 is patentable at least by virtue of its dependency.

IV. Newly Added Claim

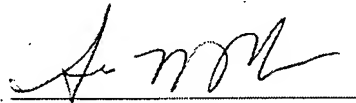
By this Amendment, Applicant has added claim 20 to provide more varied protection of the present invention.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Allison M. Tulino
Registration No. 48,294

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 31, 2008